

Amendment and Response

Applicant: Daniel R. Marshall

Serial No.: 10/663,427

Filed: September 16, 2003

Docket No.: 10002305-4 (H303.190.103)

Title: SWALLOWABLE DATA RECORDER CAPSULE MEDICAL DEVICE

REMARKS

The following remarks are made in response to the Office Action mailed July 25, 2005, in which claims 23-42 were rejected. With this Response, claims 25-37 have been amended. Claims 23-42 remain pending in the application and are presented for reconsideration and allowance.

Objection to the Specification

In the Office Action, the specification was objected to regarding the Cross Reference section of the specification. Applicant has amended the Cross Reference section accordingly. Applicant thanks the Examiner for the careful attention given to this matter.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, claims 38 and 40 were rejected under 35 U.S.C. 102(e) as being anticipated by Kilcoyne et al. U.S. Patent No. 6,285,897 (Kilcoyne) .

Kilcoyne fails to disclose Applicant's independent claim 38 which specifies a method of recording data about biologic conditions within a human body.

Kilcoyne discloses storing physiologic parameter data using a memory chip or microprocessor 116 (see Kilcoyne at Column 4, lines 62-64). Kilcoyne also discloses that a microprocessor 116 performs one or more functions including temporary storage or memory of data. See Kilcoyne at Column 6, lines 18-24, 40-45.

However, Kilcoyne fails to disclose, among other things, placing a capsule within a digestive tract of a human body wherein the capsule includes a storage device comprising an atomic resolution storage device.

First, contrary to the assertions in the Office Action, Applicant's claimed storage device of an atomic resolution storage device is not strictly defined by a single sentence of Applicant's specification at page 4, lines 8-31. For instance, the passage cited in the Office Action was incomplete in that the sentences immediately succeeding the cited passage (page 4, line 32 through page 5, lines 1-4 of Applicant's specification) further define the features of an atomic resolution storage device. Moreover, Applicant also has extensively described the atomic resolution storage device in numerous passages in the specification (see page 7, lines 18-32 to page 8, lines 1-13 and pages 9-14).

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Second, no portion of Kilcoyne teaches or suggests in any way what type of memory chip is incorporated in monitor 18, and Kilcoyne's inclusion of a nondescript memory chip/microprocessor reveals nothing to suggest or teach an atomic resolution storage device, as claimed by Applicant.

Accordingly, the assertion in the Office Action that "Kilcoyne's microprocessor including a memory chip is an example of an "atomic resolution storage device memory module" is not supported by Kilcoyne.

For these reasons, Kilcoyne fails to teach or suggest Applicant's independent claim 38. Therefore, Applicant's claimed device is patentable over Kilcoyne and allowance of claim 38 is respectfully requested. Dependent claim 40 is also believed to be allowable based upon its dependency from patentably distinct independent claim 38.

Accordingly, Applicant respectfully requests that the above 35 U.S.C. § 102(e) rejection to claims 38 and 40 based on Kilcoyne be reconsidered and withdrawn, and that these claims be allowed.

Claim Rejections under 35 U.S.C. § 103

In the Office Action, claims 23-27, 29-34, 36, and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kilcoyne in view of Iddan et al. U.S. Patent No. 5,604,531 (Iddan).

Kilcoyne fails to disclose Applicant's independent claim 23 which specifies a method of recording data internally within a human body.

Kilcoyne discloses storing physiologic parameter data using a memory chip or microprocessor 116 (see Kilcoyne at Column 4, lines 62-64). Kilcoyne also discloses that a microprocessor 116 performs one or more functions including temporary storage or memory of data. See Kilcoyne at Column 6, lines 18-24, 40-45.

However, Kilcoyne fails to recording a sensed biologic condition as data in an atomic resolution storage device memory module within a capsule while the capsule is in the digestive tract, as claimed by Applicant.

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First, contrary to the assertions in the Office Action, Applicant's claimed storage device of an atomic resolution storage device is not strictly defined by a single sentence of Applicant's specification at page 4, lines 8-31. For instance, the passage cited in the Office Action was incomplete in that the sentences immediately succeeding the cited passage (page 4, line 32 through page 5, lines 1-4 of Applicant's specification) further define the features of an atomic resolution storage device. Moreover, Applicant also has extensively described the atomic resolution storage device in numerous passages in the specification (see page 7, lines 18-32 to page 8, lines 1-13 and pages 9-14).

Second, no portion of Kilcoyne teaches or suggests in any way what type of memory chip is incorporated in monitor 18, and Kilcoyne's inclusion of a nondescript memory chip/microprocessor reveals nothing to suggest or teach an atomic resolution storage device, as claimed by Applicant.

Accordingly, the assertion in the Office Action that "Kilcoyne's microprocessor including a memory chip is an example of an "atomic resolution storage device memory module" is not supported by Kilcoyne.

In addition, as admitted in the Office Action, Kilcoyne does not explicitly teach "ingesting" or "swallowing" an inert capsule. Instead, Kilcoyne describes placing physiologic monitor 18 in the esophagus 30 (Column 7, lines 19-20) and extensively describes attaching the monitor 18 within the esophagus 30 (Columns 7-9) via several different mechanical and/or adhesive mechanisms as directed by an operator. Accordingly, Kilcoyne teaches away from ingesting an inert capsule, as claimed by Applicant.

Iddan fails to cure the deficiencies of Kilcoyne. First, Iddan fails to disclose an atomic resolution storage device. Second, Iddan fails to teach or suggest modifying a method or system such as Kilcoyne, which is directed to attaching a monitor 18 to a wall of an esophagus.

Accordingly, one cannot combine Kilcoyne and Iddan and arrive at Applicant's independent claim 23.

For these reasons, Kilcoyne and/or Iddan fails to teach or suggest Applicant's independent claim 23. Therefore, Applicant's claimed device is patentable over Kilcoyne and allowance of claim 23 is respectfully requested. Dependent claims 24-37 are also

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believed to be allowable based upon their dependency from patentably distinct independent claim 23.

In the Office Action, claims 28 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kilcoyne in view of Iddan as applied to claims 24 and 34 above, and further in view of DeMarco U.S. Patent No. 5,353,807 (DeMarco). Claims 28 and 35 are believed to allowable based upon their dependency from independent claim 23, which is believed to be allowable for the reasons presented above. In addition, DeMarco fails to cure the deficiencies of Kilcoyne and/or Iddan. Accordingly, Applicant respectfully submits that Applicant's claim 28 and/or claim 35 is patentable and allowable over Kilcoyne, Iddan, and/or DeMarco.

In the Office Action, claim 39 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kilcoyne as applied to claim 38 above, and further in view of Iddan. Claim 39 is believed to allowable based upon its dependency from independent claim 38, which is believed to be allowable for the reasons presented above. In addition, Iddan fails to cure the deficiencies of Kilcoyne. Accordingly, because one cannot combine Kilcoyne, Iddan, and/or DeMarco and arrive at Applicant's claim 28 or claim 35, Applicant respectfully submits that Applicant's claim 28 and/or claim 35 is patentable and allowable over Kilcoyne, Iddan, and/or DeMarco.

In the Office Action, claims 41 and 42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kilcoyne as applied to claim 38 above, and further in view of Gibson et al. U.S. Patent No. 5,557,596 (Gibson). Claims 41 and 42 are believed to allowable based upon their dependency from independent claim 38, which is believed to be allowable for the reasons presented above.

Gibson fails to cure the deficiencies of Kilcoyne. Neither Gibson nor Kilcoyne teach or suggest using an atomic resolution storage device as a storage device in a method of recording data about biologic conditions within a human body, as in Applicant's base claim 38 from which claims 41 and 42 depend. Accordingly, one would not combine Kilcoyne and Gibson to arrive at Applicant's claim 41 or claim 42. For these reasons, Applicant

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respectfully submits that Applicant's claim 41 and/or claim 42 is patentable and allowable over Kilcoyne and Gibson.

Accordingly, Applicant respectfully requests that the above 35 U.S.C. § 103 rejections to claims 23-37 and 41-42 based on Kilcoyne, Iddan, DeMarco, and/or Gibson be reconsidered and withdrawn, and that these claims be allowed.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 23-42 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 23-42 is respectfully requested.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Phil Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332 or Steven E. Dicke at Telephone No. (612) 573-2002, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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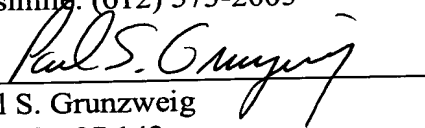
Respectfully submitted,

Daniel R. Marshall,

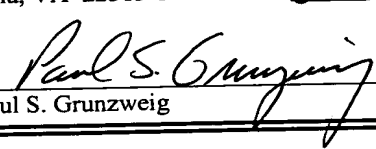
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 6th day of October, 2005.

By 
Name: Paul S. Grunzweig